

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 18-20 and 27 are rejected under 35 U.S.C. 102(e) or 103(e) over the patent Nagaoka.

The other claims were rejected over the patent to Nagaoka in combination with other references.

Claim 25 is not rejected over the art.

Claim 27 is rejected as a duplicate.

The Abstract of the Disclosure is objected to, and Information Disclosure Statement is objected as well.

Finally, the claims are objected and rejected for formal reasons.

In connection with the Examiner's objection and rejection of the claims for formal reasons, the corresponding claims have been amended and it is

believed that the grounds for these formal objections and rejections are eliminated.

In view of the Examiner's double patenting rejection, claim 27 has been canceled without prejudice.

The Examiner's indication of the allowability of claim 25 has been gratefully acknowledged. In connection with this indication, claim 25 has been amended to make it independent claims, and it is now in allowable condition. Claims 26 and 28 which depend on claim 25, contains its features and they are now in allowable condition as well.

At the same time it is respectfully submitted that claim 18, the broadest claim on file, should be considered as patentably distinguishing over the art as well.

In his rejection of claim 18, the Examiner indicated that the patent to Nagaoka discloses a filter comprising a housing with an inlet branch pipe, an outlet branch pipe, a main branch pipe, with shutoff valves, a main vibration element, and an additional filtration layer. While this is true, this reference still does not disclose the new features of the present invention as defined in claim 15, in particular, the filtration mass volume of the material of the main filtration element which is determined in accordance with the special expression, and also

does not disclose the additional filtration element which additional volume is determined in accordance with the corresponding expression. The references do not contain any hint or suggestion for these features.

As for the Examiner's rejection of the claims as being obvious under 35 U.S.C. 102(a) it is believed to be clear that the patent to Nagaoka does not teach the above mentioned features. In connection with this, it is believed to be advisable to cite the decision *in re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Nagaoka does not disclose each and every feature of the present invention which are now defined in claim 18, and therefore the anticipation rejection should be withdrawn.

As for the obviousness rejection, the references do not contain any hint or suggestion for the above mentioned features. In order to arrive at the applicant's invention from the teaching of the patent to Nagaoka has to be fundamentally modified by including into it the above mentioned features.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in *re Randolph and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that claim 18 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 19, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

As for the other references which were cited in combination with the patent to Nagaoka, these references also do not teach the new features of the present invention, and therefore any detailed comments thereon would be superfluous.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,



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